REMARKS

Claims 1-15 and 17-21 are in the case and presented for consideration.

Because Applicant's amendments and arguments have failed to advance prosecution in any meaningful way, Applicants herein withdraws amendments to claim 11, which were previously made in this case. Since claim 11 has been restored in some manner to an earlier version of the claim, the amendments to the claim presented herein do not require any further search or consideration, since such previous version of the claim has already been dealt with by the Examiner in a fully substantive manner. That is, the Examiner has already searched and considered this previous version of the claim in issuing at least one of the previous Office Actions in this case.

Claims 18-20 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. It appears that perhaps this rejection was inadvertently copied from the last Office Action since Applicants previously provided the location in the specification where the subject matter is adequately described (see Applicants response on October 20, 2006, pages 6-7)

Turning now to the present rejections, claims 1-5, 9, 11-15, and 21 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,616,876 to Cluts.

It is well settled that the burden of establishing a *prima facie* case of anticipation resides with the United States Patent and Trademark Office. *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). To meet the burden of establishing a *prima facie* case of anticipation, the Office must explain how the rejected claims are anticipated by pointing out where the specific limitations of the claims are found in the prior art. *Ex Parte Naoya Isoda* , Appeal No. 2005-2289, Application 10/064,508 (Bd. Pat. App. & Inter.2005). The Office must also explain the rejection with reasonable specificity. *Ex parte Blanc*, 13 USPQ2d 1383 (Bd. Pat. App. & Inter. 1989). Finally, "A claim is anticipated only if ***each and every element*** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The ***identical invention*** must be shown in as ***complete detail*** as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); *also see* MPEP §2131. If the Patent Office does not produce a *prima facie* case of unpatentability, then without more, the applicant is entitled to a grant of a patent. (*In re Oeitiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir.

1992); In re Grabiak, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

Applicants respectfully submit that the Office has not established a *prima facie* case of anticipation. The Office has not shown that ***each and every element*** as set forth in the rejected claims is found either expressly or inherently in Cluts '876. With respect to at least one claimed limitation, the Office has not even pointed out where the specific limitation of the claim is found in Cluts '876.

First, claim 1 recites:

> attribute means for associating a respective one of said information units with an attribute value for a ***plurality of attributes***... the selection and presentation being made without interaction by a user based on the ***plurality of attributes***

In regard to Applicant's claimed "attribute value", the Office cites "see discussion of the classification of content, col. 14, lines 28-50". In the context of the above-identified limitations, this does not explain in any reasonable fashion what the Office deems to be an "attribute value" in Cluts '876. Applicants respectfully remind the Office that it is the duty of the Examiner to specifically point out each and every limitation of a claim begin rejected as per §1.104(c)(2) of Title 37 of the Code of Federal Regulations and section 707 of the M.P.E.P., which explicitly state that "the particular part relied on must be designated" and "the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified." Referring vaguely to columns and lines without

any explanation hardly satisfies 37 C.F.R. §1.104(c)(2). Furthermore, the Office is now officially on notice that the pertinence of the Cluts reference with respect to this element is not apparent, and although such pertinence should have been clarified in the first place, the Office now has an opportunity to make the required clarification in the Advisory Action, if the claim(s) at issue are not allowed.

Furthermore, the Office indicates that the claimed *attribute value* is taught by "classification of content" and the claimed *plurality of attributes* are taught by "disclosure of different style categories". Classification of content, however, is broader than different style categories. That is, different style categories are a subset of classification of content because different style categories are a form of subjective classification of content as explained in the cited location. However, the claimed *plurality of attributes* are clearly not a subset of the claimed *attribute value* in the context of the claims. It is the opposite. Therefore, the Office's equivalence of an *attribute value* to "classification of content" and *plurality of attributes* to "disclosure of different style categories" is illogical. The only logical understanding of the cited column and line numbers of Cluts '876, in the context of Applicant's claims, is that the different style categories (e.g., 1960's, 1970's, etc) are *attribute values* for the *single attribute* of style. However, since only one attribute is disclosed (i.e., style), the claimed *plurality of attributes* is not taught or suggested.

In addition, the Office makes a completely ***different argument*** with respect to the ***same limitation*** in claim 11. With respect to claim 11, the Office identifies a "Weight" (e.g., 1, 1, 7) for the different Style Categories as the claimed *attribute values* (*see* col. 15, lines 35-45; *also see* the Office Action states "and associated attribute values 1, 1, 7, etc"). The Office further identifies "additional attributes in the form of subcategories 'New York City Rap'...". This conflicts entirely with the Office's analysis of claim 1. How can the pertinence of the Cluts '876 reference be apparent or understood by Applicants if the Office makes completely different arguments with respect to the same limitation in different claims? As a matter of law, Applicants respectfully submit that the Office has not established a *prima facie* case of anticipation because the conflicting explanations by the Office with respect to claims 1 and 11 cannot be reconciled. This is particularly the case since Applicants disagree with the Office's rational with respect to its analysis as to both claims 1 and 11.

Furthermore, the Office's analysis of claim 11 cites to Cluts' example of rap music categories. Cluts teaches that it may be desirable to use more precise subcategories in order to more accurately describe the style attribute. To this end, Cluts teaches the use of playlist-specific style tables based on the following:

> "For example, the ***default*** style tables may include a single category for rap music. However, music aficionados may prefer to further classify rap music into more precise subcategories, such as New York City rap, Los Angeles Rap, Male Rap, Female Rap, etc.

> The present invention allows playlist-specific style tables to be loaded into the system with each playlist. Therefore, playlist publishers may elect to use the ***default*** style tables, ***or*** may ***provide their own***. Each playlist-specific style table may reclassify all of the artists whose music appears on the system, or only artists of particular interest. Thus, in the previous rap music example, a publisher of a rap music playlist may provide a style table that ***reclassifies*** those artists whose music appears in the rap playlist. In other words, a playlist publisher can ***recategorize*** the artists that are important to that publisher, and for which they want to make finer distinctions. (emphasis added; see Cluts '876, col. 15, lines 50-67)

Thus, the playlist publisher can use either a default style table (i.e., Rap) or provide their own style table (i.e., New York City rap, Los Angeles Rap, Male Rap, Female Rap) to reclassify or recategorize artists in a playlist. Thus, Cluts teaches that a playlist publisher can create additional, more nuanced values for the style attribute in a customized playlist-specific style table which is different or alternative to the "default" style table. In effect, only the singly chosen playlist-specific style table achieves this reclassification or recategorization. Cluts '876 does not disclose that the default style tables and alternative playlist-specific style tables are used together. Hence, selection and presentation is based only on either one of a category in the default style table (i.e., Rap) or the so-called subcategories in a customized style table (i.e., New York City Rap, etc) and ***not*** on both the category (default style table) and the subcategories (customized style table). In either case (default style table or customized style table), there is only a single style attribute. With the default style table containing Rap, "Rap" is a value for the style attribute. With the customized style table, the different subcategories are different values for the style attribute.

On page 18 of the Office Action dated July 20, 2006, the Office states that "the disclosure of subcategories at col. 15, lines 47-55 is analogous to the claimed invention as disclosed in the Applicant's specification with regard to 'genre' and 'style, or sub-genre' attributes, page 2, lines 23-33 and as illustrated in drawing Figure 2." Applicants respectfully submit that this argument is misplaced. As explained in the specification, the genre and sub-genre are ***both*** defined with values and therefore ***both*** play a role (*see* page 2, lines 27-29, "For example, ***in addition to*** the genre attribute, a 'style' attribute, i.e., a sub-genre may be defined, whose set of valid attribute values depends on the currently selected value of the genre attribute". By stark contrast, Cluts clearly states that the default style table includes a single category for rap music (col. 15, lines 50-52) and that "playlist publishers may elect to use the default style tables, or may provide their own." By providing their own (i.e., New York City rap, Los Angeles Rap, etc), Cluts '876 only discloses the use of a plurality of style categories or values for the style attribute. Cluts '876 does not disclose anywhere that ***both*** the "Rap" category and the "New York City Rap" subcategory are both defined for a single style table. Rather, Cluts '876 only discloses that customized style tables can replace the default style tables which only contain the "Rap" category.

Regarding the style EQ disclosed in Cluts '876, Applicants reiterate the arguments in the last response filed on October 20, 2006. Furthermore, even assuming *arguendo* (not conceded) that the Style EQ function constitutes multiple attributes, Applicants respectfully submit that claim 1 still recites at least one limitation not taught or suggested by Cluts '876 based on how the style EQ function works. Claim 1 recites:

> random selection means for automatically randomly selecting and presenting for playback a unit whose attribute value meets a criterion, the selection and

> presentation for playback being made without interaction by a user based on the plurality of attributes

Thus, claim 1 not only recites automatically randomly selecting and presenting for playback a unit whose attribute value meets a criterion, but also that the selection and presentation (which is automatic and random) be made without interaction by a user based on the plurality of attributes. By stark contrast, the style EQ function is a user interactive function.

> Second, the style EQ feature allows the subscriber to alter the mix of the songs that are played from the playlist by adjusting one or more of the indicators. Thus, if the subscriber does not care for one of the styles in the playlist, the subscriber can decrease the amount of that style that is played. Similarly, the subscriber can boost the styles of music that he or she enjoys, which acts as a filter and does not alter the actual content of the playlist. This allows a subscriber to listen to a playlist in a variety of different ways.

Also, the style EQ function is not random. It is not automatic. A remote control unit is used to select and play, or adjust the song from a mix of songs already on a playlist. Cluts '876 states the following:

> The style EQ function also allows the subscriber to adjust the mix of songs that is played from the playlist. For example, if the subscriber dislikes acid rock and heavy metal, the ***subscriber can "attenuate" those styles by using the remote control unit to move those faders to their lowest position.*** Likewise, the subscriber can "boost" the amount of soft rock songs that are played by moving the fader upward.

Thus, Cluts '876 does not teach or suggest "the selection and presentation for playback being made without interaction by a user based on the ***plurality of attributes***," where the Office defines the plurality of

attributes to be the Style EQ function. In Cluts '876, the selection and presentation for playback is made ***with interaction by a user*** based on the style EQ function.

Independent claims 14 and 21 recite similar limitations to claim 1, and are therefore believed to be patentable for at least the reasons above.

In addition, claim 1 recites:

> random selection means for automatically randomly selecting and presenting ***for playback*** a unit whose attribute value meets a criterion, the selection and presentation ***for playback*** being made without interaction by a user based on the plurality of attributes.

Applicants respectfully submit that the Office has not established a *prima facie* case of anticipation. The Office has not shown where Cluts '876 teaches "selection and presentation for ***playback*** being made without interaction by a user. Instead, the Office only refers to songs that are selected and presented for a ***playlist***. The Office cites col. 14, lines 12-27. Cluts '876 states at the outset at line 12:

> Generally described, the "more like" function of the present invention provides systems and methods for using a seed song (e.g., the current song) ***to add new songs to a playlist***. This is accomplished on the basis of subjective style classifications and style weightings that are associated with the songs in the audio content database.

It is clear from the plain language of Cluts '876 that the Office is relying on addition of songs to a ***playlist***. A song selected for a playlist and a

song selected for playback are not the same thing. Although Applicants clearly explained this point in the last response, the Office never responded. Thus, Applicants position is uncontroverted at this point, and the Office is deemed to have not established a *prima facie* case. Otherwise, it would have responded to Applicant in the present action.

It is noted that the Office has newly added a further citation to the operation of the Style EQ in the present Office Action (which appears to be the only newly added subject matter with respect to the previous Office Action), but as explained above, operation of the style EQ is not random, automatic, without user interaction, or based on a plurality of attributes as recited. A subscriber uses a remote control to choose what songs should be played based on what the subscriber is in the mood for. This is the complete opposite of what claim 1 recites.

Claim 11 recites:

> the method comprises a step of automatically randomly selecting and presenting, without interaction by a user, ***audio or video media content of a unit*** from said collection of information units whose attribute values meet a criterion for said at least a first attribute

Again, the Office has not established a *prima facie* case of anticipation. As explained above, the Office's references to the "More Like" function for using a seed song to add new songs to a ***playlist*** is not the same as automatically randomly selecting and presenting, without interaction by a user, ***audio or video media content of a unit*** from a collection of information units, as recited in claim 11. A ***playlist*** is a ***list*** of songs. The ***playlist*** does not include the songs themselves. The songs are stored separate from the ***playlist***. Only a ***list*** of the units containing the audio or video media content to be presented is provided in the ***playlist***

of Cluts '876. The Office has not shown where Cluts '876 actually teaches automatically randomly selecting and presenting, without interaction by a user, ***audio or video media content of a unit*** from a collection of information units. By contrast, the Office has only identified presenting lists of songs which is not the same thing as presenting ***audio or video media content of a unit***.

Again, the Office also newly sites to the Style EQ function. Applicants reiterate that operation of the style EQ is not random, automatic, or without user interaction. A subscriber uses a remote control to choose what songs should be played based on what the subscriber is in the mood for. This is the complete opposite of what claim 11 recites.

Claim 21 recites similar limitations to claims 1 and 11 and is patentable for at least the same reasons.

All dependent claims are patentable for at least the same reasons as the independent claims discussed above.

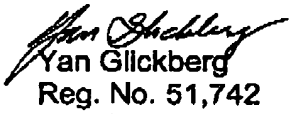
Claims 6-8 and 17-20 were rejected under 35 U.S.C. 103(a) as neing obvious from Cluts '876 in view of Dunning et al.

Applicants reiterate the arguments presented in the last response and respectfully request reconsideration. Accordingly, these claims are believed to be patentable as well.

If any issues remain which may be resolved by telephonic communication, the Examiner is respectfully invited to contact the undersigned at the number below, if such will advance the application to allowance.

The Commissioner is hereby authorized to credit any overpayment or charge any fee (except the issue fee) to Account No. 14-1270.

Respectfully submitted,



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